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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/704,256	11/01/00	HUISH F	04193.009/13

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TOWNSEND AND TOWNSEND AND CREW
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EXAMINER
DELCOTTO,G

ART UNIT	PAPER NUMBER
1751	6

DATE MAILED: 07/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/704,256	Huish et al
Examiner	**Art Unit**
Greg Del Cotto	1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-23 is/are pending in the applica

4a) Of the above, claim(s) 22 and 23 is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-21 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 1-23 are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

1. Claims 1-23 are pending.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-21, drawn to an alpha fatty acid ester composition, classified in class 510, subclass 155.

3. II. Claims 22 and 23, drawn to a method of making an alpha sulfofatty ester composition classified in class 510, subclass 459

4. The inventions are distinct, each from the other because of the following reasons:

5. Inventions and are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of Group I can be made by a materially different process such as by mixing all the components together simultaneously to form the detergent composition .

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Mark G. Sandbaken on July 2, 2001, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22 and 23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to instant claim 17, it is vague and indefinite in that it is unclear what is to meant by "substantially". The specification provides no guidance or definition in this instance as what is meant by the term "substantially" and one of ordinary skill in the art would not be able to determine the metes and bounds of the claimed invention.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1-5, 7, 9-14, and 16-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rolfes (US 5,972,861).

Rolfes teaches detergent compositions comprising a surfactant mixture containing effective amounts of a base soap, and one or more fatty acid methyl ester sulfonates containing an alkyl chain having 6 to 20 carbon atoms. See column 2, lines 15-35. This surfactant mixture is usually present in an amount of from 5% to 85% by weight of the composition. See column 2, lines 40-55. Additionally, the compositions may contain minor amounts of additional surfactant materials such as alcohol ethoxy sulfates, alkyl benzene sulfonates, alkyl ethoxylates, alkyl amine oxides, betaines, etc. The surfactants may be present in individual amounts from 0.5 to 5% by weight. Other non-surfactant additives include sequestrants, builders, enzymes, brighteners, etc.

The composition can be in solid, liquid, paste, granular, agglomerate, or bead form with the solid or semi-solid form being preferred. See column 4, lines 50-65. Note that, the instant claims are product-by process claims and the Examiner asserts that the patentability of a product does not depend on its method of production; if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Specifically, Rolfes teaches laundry bars containing 62% base soap, 4% sodium carbonate, 5% alkyl benzene sulfonate, 5% C16-C18 fatty acid methyl ester sulfonate, and 24% of moisture/miscellaneous. Note that, the Examiner asserts that this bar composition would have a free moisture content of less than 6% since bars generally do not contain a high amount of water and the miscellaneous ingredients account for a large portion of the 24% by weight. Accordingly, the broad teachings of Rolfes appear to anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of Rolfes are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at the claimed amount of moisture in the composition in order to provide the optimum cleaning properties to the composition since Rolfes et al teach that the amount of miscellaneous ingredients and water added to the composition may be varied. Note that, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.

16. Claims 1, 4, 5-10, and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 336,740.

'740 teaches a detergent composition including a surfactant system at least 50% by weight of which comprises a fatty acid ester sulfonate, and a nonionic surfactant having an HLB of less than 10.5, preferably less than 9.5. See page 2, lines 45-58. The fatty acid ester sulphonate salts can be produced from fatty acids in a conventional manner and starting fatty acids are those derived from tallow, palm oil or coconut oil. Other additional surfactant materials may be used in the compositions such as alkyl sulfates and sulfonates, etc. See page 3, lines 35-50. The compositions may also contain a builder material such as carbonates, bicarbonates, silicates, etc. See page 3, lines 50-60. Examples of other ingredients which may be present include enzymes such as proteases, cellulases, amylases, fluorescent agents, etc. See page 4, lines 5-30. The detergent compositions may be prepared by a number of different methods and in the case of granular product, they may be prepared by dry-mixing or coagglomerations. See page 4, lines 15-30. Note that, the instant claims are product-by process claims and the Examiner asserts that the patentability of a product does not depend on its method of production; if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

'740 does not specifically teach a composition having reduced di-salt formation containing a first portion of an alpha sulfofatty acid ester, a second portion of additional detergent

components wherein the second portion has a free moisture content of less than 6% by weight, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition having reduced di-salt formation containing a first portion of an alpha sulfofatty acid ester, a second portion ofadditional detergent components wherein the second portion has a free moisture content of less than 6% by weight, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of '740 suggest a composition having reduced di-salt formation containing a first portion of an alpha sulfofatty acid ester, a second portion ofadditional detergent components wherein the second portion has a free moisture content of less than 6% by weight, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

17. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminsky (US 4,487,710).

Kaminsky teaches granular detergent compositions which contain an anionic surfactant, an ethoxylated surfactant, and a water-soluble neutral or alkaline salt. Suitable anionic surfactants include the water-soluble salts of esters of alpha-sulfonated fatty acids containing from about 6 to 20 carbon atoms in the fatty acid group and from about 1 to 10 carbon atoms in the ester groups.

The ethoxylated surfactant is used in amounts from about 1% to about 50% by weight and suitable ethoxylated surfactants include the ethoxylated alkyl sulfates, ethoxylated nonionic surfactants, etc. See column 4, line 55 to column 5, line 30. Suitable water-soluble neutral or alkaline salts include alkali metal carbonates, silicates, borates, etc. See column 5, lines 50-60. Optional components include suds suppressors, anti-corrosion agents, dyes, optical brighteners, enzymes, perfumes, etc. See column 6, line 54 to column 7, line 45. Note that, the instant claims are product-by process claims and the Examiner asserts that the patentability of a product does not depend on its method of production; if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Kaminsky does not specifically teach a composition having reduced di-salt formation containing a first portion of an alpha sulfofatty acid ester, a second portion ofadditional detergent components wherein the second portion has a free moisture content of less than 6% by weight, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition having reduced di-salt formation containing a first portion of an alpha sulfofatty acid ester, a second portion ofadditional detergent components wherein the second portion has a free moisture content of less than 6% by weight, and the other requisite

components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Kaminsky suggests a composition having reduced di-salt formation containing a first portion of an alpha sulfofatty acid ester, a second portion of additional detergent components wherein the second portion has a free moisture content of less than 6% by weight, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

18. Claims 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rolfes (US 5,972,861).

Rolfes is relied upon as set forth above. However, Rolfes does not specifically teach a composition which is substantially free of secondary anionic surfactant and contains an enzyme in addition to the other requisite components of the composition as recited by the instant claims.

19. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rolfes (US 5,972,861) as applied to claims 1-5, 7, 9-14, and 16-20 above, and further in view of Kaminsky (US 4,487,710) or EP 336,740.

Rolfes is relied upon as set forth above. However, Rolfes does not teach the specific builder material as recited by instant claim 6.

Kaminsky or '740 are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a builder material such as a silicate in the cleaning composition taught by Rolfes,

with a reasonable expectation of success, because Kaminsky or '740 teach the use of silicates as builder materials in similar detergent compositions and Rolfes teaches the use of builder materials in general.

Double Patenting

20. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

21. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 09/574764. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-27 of 09/574764 encompass the material limitations of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

22. Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim1-25 of U.S. Patent No. 6,057,280. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-25 of US 6,057,280 encompass the material limitations of the instant claims.

Allowable Subject Matter

23. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With respect to instant claim 21, none of the references of record, alone or in combination, teach or suggest a composition containing a coated alpha sulfo fatty acid ester in addition to the other requisite components of the composition as recited by the instant claims.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

25. Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (703) 308-2519. The examiner can normally be reached on Monday thru Friday from 9:30AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

GRD
July 14, 2001

GREGORY DELCOTTO
PRIMARY EXAMINER

GREGORY DELCOTTO
PRIMARY EXAMINER